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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
WANG, SHENGJUN				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/964,143

Applicant(s)

MCLAUGHLIN, JAMES HUGH

Examiner

Shengjun Wang

Art Unit

1617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37 and 44-59 is/are pending in the application.
- 4a) Of the above claim(s) 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on April 21, 2009 has been entered.

Claim Rejections 35 U.S.C. 112

- a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 44-59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new limitation "range of 4:1 to 2.1:1" lacks support from the application as originally filed. Particularly, the application as originally filed never discloses a ratio of 2.1:1. It is noted the specification disclose a broader range of 7:1 to 1:1, and 5:1 to 2:1. However the specification provides no particular example with the ratio of emollient and carboxylic salt at about 2.1:1. Note, The introduction of claim changes which involve narrowing the claims by introducing elements or limitations which are not supported by the as-filed disclosure is a violation of the written description requirement of 35 U.S.C. 112, first paragraph. See, e.g.,

Fujikawa v. Wattanasin, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996). See, also Purdue Pharma L.P. v. Fausling Inc., 230 F.3d 1320, 1328, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000) (“[T]he specification does not clearly disclose to the skilled artisan that the inventors... considered the... ratio to be part of their invention.... There is therefore no force to Purdue’s argument that the written description requirement was satisfied because the disclosure revealed a broad invention from which the [later-filed] claims carved out a patentable portion”).

Claim Rejections 35 U.S.C. 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 44-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zabotoc et al. (US 4,673,526), and Barker et al. (US 5,360,824, of record) in view of Kellner (US 6,042,815, of record), McAtee et al. (US 6,153,208, of record), Stewart et al. (US 6,197,281), Geria (US 4,992,476), Daniel et al. (US 5,891,449), and Gagnebien et al. (US 5,888,951).

5. Zabotoc et al. teaches an anhydrous cosmetic composition for deep cleansing of skins comprising about 50-95 % of oily phase, about 1-30 % of emulsifying agent (surfactant), and about 1-10% of particulate abrasive agents. The composition is preferred in gel forms. See, particularly, col. 1, lines 7-20, line 66 to col. 2, line 12, and the claims. The oily phase comprising oils, which may be animal oil, vegetable oil, mineral oil, silicone oil or synthetic ester, of fatty acid, fatty alcohol, the oily phase may also comprising wax, which includes cetyl alcohol, stearyl alcohol, and salt of fatty acids, such as calcium, magnesium and zinc salts of

stearate, myristates, oleate, lanolate et al. See, particularly, col. 2, line 13 to col. 4, line 15.

Barker teaches skin cleansing composition comprising an oil phase with water soluble abrasive particulates suspended in the oil phase. sodium chloride particulates are disclosed as one of those particulate. See, particularly, the claims.

6. The primary references do not teach expressly the particular percentage of each and every ingredient herein claimed, or the employment of particular ingredients, such as particular abrasive agents, particular oil, calcium stearate, or the employment of sodium chloride, pumice, kernel starch as a particulate ingredients, and sodium cocoyl N-methyl taurate as the surfactant.

7. However, Kellner teaches water and oil emulsion solid cosmetic compositions. The composition comprising up to 30% of emollient oil, both natural and synthetic oil may be employed (see, particularly, col. 9, line 29 to col. 11, line 62. Kellner further discloses that addition emollient materials, such as fatty alcohol, wax, etc., as oil phase gelling agent may be employed up to 30% (see, particularly, col. 2, lines 66-67; col. 7, line 45 to col. 9, line 26). Kellner further teaches that up to 20 % of primary gelling agent may used, wherein the preferred primary gelling agent are salt of fatty acid, particularly, calcium stearate (see col. 2, lines 24-65). Surfactants up to 20% are desirable in the composition. Surfactants, including cationic, anionic nonionic and zwitterionic surfactants are suitable (see, col. 16, line 9 to col. 19, line 34). The composition may comprise up to 50% of particulate matter, the particulate matter may be organic or inorganic, such as corn starch, mica, etc. (see col. 19, lines 37-61). Stewart et al. teaches that polyvalent soaps, such as calcium stearate are well known to be useful as thickener fro making oil-based gel. See, particularly, col. 9, lines 24-29. Geria et al. teaches that pumice is known to

be useful as abrasive particles in cosmetic composition. See, particularly, col. 7, lines 25-40.

McAtee disclosed that sodium cocoyl methyl taurate is similarly useful as other anionic surfactant in cleansing composition. (col. 20, lines 1-13). Daniel et al. teaches that kernel flour is known to be useful as abrasive agent in cleansing composition. Gagnebien et al. teaches that macadamia oil is known to be used in cleansing composition. See, particularly, col. 4, lines 35-40.

8. Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a composition with the particular percentages of each and every components herein since the percentage range herein defined are either encompassed by, or overlapped with the range disclosed by the primary reference. Note it is well settled that in the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Also see MPEP 2144.05. The employment of the particular ingredients such as kernel flour, sodium chloride, pumice, sodium N-cocoyl N-methyl taurate, macadamia oil and calcium stearate is obvious since all these ingredients are known to be useful in the cleansing composition. The employment of such components in the composition is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388). The employment of sodium chloride is obvious because sodium chloride particulate is known to be useful in cleansing composition. The employment of calcium stearate is further obvious in view the fact that it is known to be useful as thickener in oil based composition.

Response to the Arguments

Applicants' amendments, remarks and the declaration under 37 C.F. R. § 1.132 submitted April 21, 2009 have been fully considered, but are not persuasive. It is noted that the declaration is to correct an error in the earlier declaration and provide no new evidence for rebutting the rejections on the record.

The examiner reiterates his arguments presented in the examiner's answer mailed 2/3/2009.

9. The declarations under 37 CFR 1.132 filed December 31, 2007 and July 1, 2008 are insufficient to overcome the rejection of claims 44-59 based upon Zabotto et al. (US 4,673,526), Barker et al. (US 5,360,824, of record), Kellner (US 6,042,815, of record), McAtee et al. (US 6,153,208, of record), Stewart et al. (US 6,197,281), Geria (US 4,992,476), Daniel et al. (US 5,891,449), and Gagnebien et al. (US 5,888,951) as set forth in the last Office action because: It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. Particularly, the commercial product is composed of specific ingredients with specific amounts, claims herein encompass a variety of ingredients with a broad range of amounts for the ingredients. Claim 59 only requires some of the ingredients in the commercial product, not all the ingredients. Further, claim 59 lacks limitation of the amounts of the ingredients. *Also, the example tested in the declaration has a ratio of emollient and fatty acid salt is 2.1:1, which is the end point of the claimed range (4:1 to 2.1:1). There is no evidence that any alleged superior properties in the tested example would have been extrapolated to the full range as claimed herein.*

10. Furthermore, there is no prima facie case of a nexus between the commercial success and the claimed invention. Applicants assert a commercial success residing in claimed invention, but fail to. An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus.

1. Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. In *re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam “cups” used in vending machines was not commensurate in scope with claims directed to thermoplastic foam “containers” broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. It is well established that commercial success must be derived from the claimed invention, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. In *re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973). See, MPEP 716.03.

2. The declaration submitted July 1, 2008 fails to establish the sell is actually due to the invention, not other marketing factors.

3. In response to appellants’ arguments against the references individually, the examiner again maintains that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). McAttee et al. (US 6,153,208, of record), Stewart et al. (US 6,197,281), Geria (US 4,992,476), Daniel et al. (US 5,891,449), and Gagnebien et al. (US 5,888,951) are cited to show that some of the particularly ingredients employed herein are known in the art for their intended function herein. The arguments that those references individually do not teach the claimed composition are not persuasive. The cited references as a whole teach that each and every ingredients employed herein is known in the art as useful in skin care product and is known to be used in combination with the others.

As the Supreme Court recently reiterated "the need for caution in granting a patent based on the combination of elements found in the prior art" (*KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007)), particularly where there is "no change in their respective functions" (id). In other words, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results" As shown by the cited references as a whole, all the elements are known in the prior art for their function, The claimed invention yield no more than what predicted by the prior art.

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion and motivation are found in the cited references and

in the knowledge generally available to one of ordinary skill in the art. Applicants particularly argue that since Kellner teach a composition contains a significant amount of water and is in solid form, so there is no motivation to combine Kellner with Zabotto et al and Barker, which teach anhydrous composition. The Arguments are not persuasive. All the references teach skin care products. All the references teach the usefulness of emollient, surfactant, and fatty acid salt in skin care products. It is particularly noted that Zabotto et al. teach fatty acid salts herein. Zabotto et al. Do not teach expressly the amount, or function of the fatty acid salts. Kellner et al. teach the function of the fatty acids salts and a broad range of amounts of the salts. Therefore, it would have been obvious to one of ordinary skill in the art to employ fatty acid salt, as well as other known skin care ingredients herein in the amounts known in the art for making a skin care composition.

With respect to particulate abrasive, appellants argue that

The particulate abrasives of Zabotto are described as "hydrosoluble," but are not disclosed to be mildly abrasive, but non-irritating - a limitation required by base claim 44.

The examiner contends that the functional limitations "mildly abrasive, none irritating" would have been within the purview of one of ordinary skill in the art. Who would want a "none mildly, irritating" ingredient in a skin care products?

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shengjun Wang/
Primary Examiner, Art Unit 1617